

Application Serial No. 09/091,510
Amendment dated September 9, 2004
Reply to Office action of April 9, 2004

REMARKS

Claims 1, 3, 4, 5, 7, 8, 10 through 33, 35 through 45, 59, 60, 65 through 68 and 70 through 85 remain pending in this application. Claim 6 is cancelled herein. Reconsideration of this application is respectfully requested in view of the following remarks.

Interview Summary:

In accordance with the provisions of 37 C.F.R. § 1.133(b), the Applicants submit the following summary of the Office interview that took place on August 31, 2004 between the undersigned representative of the Applicants and Examiner Brown.

The Applicants thank Examiner Brown for the many courtesies extended to the undersigned representative of the Applicants during the Office interview that took place August 31, 2004.

Discussed in the Interview were Hawkins et al., US 6,005,561, Green et al., US 5,664,110, and Aker, "The Macintosh Companion", as well as the Office action's reasons for combining them. The arguments made by the undersigned representative of Applicants are reiterated substantially below. No agreement was reached, but the rejections based on Hawkins will apparently be reconsidered upon receipt of this response.

Response to Arguments:

The Applicants acknowledge with appreciation the consideration of the arguments filed August 26, 2003.

Claim Rejections - 35 U.S.C. § 112:

Claim 6 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claim 6 has been cancelled. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

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The Office action rejects claims 1, 3, 4, 7, 8, 10 through 14, 16 through 22, 28 through 30, 32, 33, 35, 36, 37, 39 through 45, 66, 68 70, 71, 73 through 76, 80, 81, 83, 84, and 85 under 35 U.S.C. § 103 as unpatentable over Hawkins *et al.*, US 6,005,561 in view of Green *et al.*, US 5,664,110. The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Hawkins uses a 'backchannel' (col. 12, line 33) for communication from the user terminal to the headend; see also col. 15, lines 46 to 48. First of all, this is clearly not a modem, but an always-on connection forming part of a broadcast system; see the prior art interactive system of Figure 2 and col. 4, lines 17 to 52, particularly line 40. Hence the motivation proffered on page 4, last paragraph of the office action is not supported by Hawkins; even in the low bandwidth system discussed on column 18, lines 11 to 19, there is no suggestion to replace the broadcast system by a modem connection (which would be totally impractical for video transmission), and no reason to add a modem connection to the broadcast system, as the broadcast system already includes a backchannel.

Moreover, there is no disclosure in Hawkins of any communication from the headend to the user terminal in anything other than the broadcast channels (see col. 15, lines 53 to 57). Hence, even if the backchannel were implemented instead via a modem, as in Green, there would be no suggestion from Hawkins to use the modem to 'transmit data to ... a remote site for on-line interaction via the interactive image ...' as required by claims 1 and 28.

More importantly, Hawkins quite clearly teaches that interactive content requests should not be handled through the backchannel. Column 12, lines 4 to 6 teach that 'The broadcast data stream contains all information that the end-user terminal needs to provide basic services for interactive video delivery service', and at lines 30 to 33 'Information is then retrieved from the end-user terminal's memory cache, or the broadcast stream, before any request is made to the head-end server on the backchannel'.

Column 14, lines 50 to 54 are particularly telling: '...to the viewer it appears that the system is interacting with the host to obtain the information requested by the viewer.' but the system is not in fact interacting with the host via the backchannel (col. 15, lines 37 to 39). Instead, the interactive content is all carried in the broadcast channel and cached locally at the

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terminal.

The Office action refers to col 9, lines 34 to 45 of Hawkins as disclosing media objects including video, but the passage following at lines 45 to 60 makes it clear that the media objects include control mechanisms for other objects, and that these objects are transmitted by the network, 'thereby minimizing backchannel communication'. In other words, all the interactive video content is handled locally by the user terminal, without the need to request other linked objects from the head end.

Finally, we refer to column 17, line 63 to column 18, line 2: 'However, the data stream [i.e. on the broadcast channel] includes all necessary media objects which are required by the subscriber to obtain information about the various services from the service provider. Once the viewer decides upon a particular service or program, the viewer can make a selection, and only at that time does the viewer make use of the backchannel to the head end.' Again, this emphasizes that all interactive images in Hawkins are handled locally and do not require data to be transmitted to a remote site.

Green does not add anything to Hawkins except to show that communication with a remote site can be implemented by a modem. The 'Order' button 62, 72 causes a communication to be initiated via a modem 38, but does not suggest that the modem would 'transmit data to ... a remote site for on-line interaction via the interactive image ...' as required by claims 1 and 28.

Claims 70 and 80 require that the processor output for display 'a further interactive image derived from said image data, said information data, and said received on-line data'. For the reasons given above, Hawkins teaches directly away from the use of on-line data, received via a modem, to display an interactive image. Instead, Hawkins teaches that all interactive images should be carried by the broadcast channel.

The Office action appears to rely on Aker for the teaching of an interactive image (bottom of page 5), but doesn't cite it in the grounds for rejection on page 7. However, nothing in Aker makes up for the deficiencies of Hawkins and Green. In fact, the icons in Aker are clearly generated locally and are derived neither from a broadcast stream or a modem connection.

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It is thus submitted that no processor responsive to stored information data to output for display an interactive image derived from video data and information data, as recited in claims 1 nor 28, is disclosed in either Hawkins, Green or Aker. Since neither Hawkins, Green or Aker disclose a processor responsive to stored information data to output for display an interactive image derived from video data and information data, their combination cannot, either.

Furthermore, disparate references, no matter how notoriously well known they may or may not have been at the time of the invention, does not rise to the level of proof need for a rejection under 35 U.S.C. § 103(a). 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), rather, require the claimed *combination* of elements to have been obvious to persons of ordinary skill in the art at the time the invention was made, not just any particular individual element.

Merely pointing to descriptions of one or another of the individual elements, such as, for example, activating a modem using a GUI, does not render the claimed *combination* of elements obvious.

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), cert. denied, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. See *In re Rouffet*, 47 USPQ2d at 1457. If identification of each claimed element in the prior art were sufficient to negate patentability, the Office action could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. See *Id.* To prevent the use of hindsight based on the teachings of the patent application, the Office action must show a motivation to combine the references in the manner suggested. See *Id.* at 1457-1458.

The Applicants reiterate their requests for evidence to support the various takings of Official Notice in the Office action. Otherwise, the takings of Official Notice are traversed.

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Accordingly, claims 1, 28, 70, and 80 and their dependent claims are believed to be patentable over Hawkins in view of Green and Aker. Withdrawal of the rejection of claims 1, 28, 70, and 80 is earnestly solicited.

Claims 5, 15, 31, 38, 65, 67, 72 and 82 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hawkins in view of Green and Aker (The Macintosh Companion), and further in view of Hendricks, WO 94/14284. The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Claims 5, 15, 31, 38, 65, 67, 72 and 82 depend from one of claims 1, 28, 70 or 80. Neither Hawkins, Green, nor Aker describe responding to stored information data to output for display an interactive image derived from video data and information data as discussed above with respect to claims 1, 28, 70, and 80. It is respectfully submitted that Hendricks does not, either.

Since neither Hawkins, Green, Aker nor Hendricks disclose responding to stored information data to output for display an interactive image derived from video data and information data separately, their combination cannot, either. Claims 5, 15, 31, 38, 65, 67, 72 and 82 are thus submitted to be allowable. Withdrawal of the rejection of claims 5, 15, 31, 38, 65, 67, 72 and 82 is earnestly solicited.

Claims 23 through 27, 77 and 78 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hawkins in view of Green and Aker, and further in view of Schutte, US 5,319,454. The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Claims 23 through 27 and 78 depend from claim 1, while claim 77 depends from claim 70. Neither Hawkins, Green, nor Aker describe a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as discussed above with respect to claims 1, 28, 70, and 80. It is respectfully submitted that Schutte does not, either. Since neither Hawkins, Green, Aker nor Schutte disclose a processor responsive to stored information data to output for display an interactive image derived from video data and information data separately, their combination cannot, either. Claims 23 through 27, 77 and 78 are thus submitted to be allowable. Withdrawal of the rejection of claims 23

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through 27, 77 and 78 is earnestly solicited.

Claims 59, 60, and 79 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hawkins in view of Green and Aker, and further in view of Vlahos, US 5,907,315. The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Claims 59 and 60 depend from claim 1, while claim 79 depends from claim 70. Neither Hawkins, Green, nor Aker describe a processor responsive to stored information data to output for display an interactive image derived from video data and information data, as discussed above with respect to claims 1, 28, 70, and 80. It is respectfully submitted that Vlahos does not, either. Since neither Hawkins, Green, Aker nor Vlahos disclose a processor responsive to stored information data to output for display an interactive image derived from video data and information data separately, their combination cannot, either. Claims 59, 60, and 79 are thus submitted to be allowable. Withdrawal of the rejection of claims 59, 60, and 79 is earnestly solicited.

Conclusion:

In view of the above amendments and remarks, it is believed that the claims satisfy the provisions of the patent statutes and are patentable over the prior art. Reconsideration and early notice of allowance are requested.

Respectfully submitted,

By 

Thomas E. McKiernan
Reg. No. 37,889
Attorney for Applicants
ROTHWELL, FIGG, ERNST & MANBECK
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202)783-6040